

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Peter J. Malnekoff

Serial No.: 09/871,867

Filed: June 1, 2001

For: AN AUTOMATED
GEMSTONE EVALUATION
SYSTEM

Group Art Unit: 3622

Examiner: M. Kemper

I hereby certify that this paper is being deposited with the United States Postal Service, first class postage prepaid, addressed to: Commissioner for Patents, Box AF, P.O. Box 1450, Alexandria, VA 22313-1450

July 28, 2003

Gregory C. Mayer Reg. No. 38,238

DECLARATION OF PETER J. MALNEKOFF PURSUANT TO 37 C.F.R §1.131

I, Peter J. Malnekoff, do hereby declare as follows:

- 1. I am the sole, named inventor of the subject matter disclosed and claimed in the above-captioned application.
- 2. I have been informed that the above-captioned application is a continuation of U.S. Patent Application Serial No. 09/157,470, filed September 21, 1998 (hereinafter, "the '470 application"), and that the claims pending in the above-captioned application are drawn to the same subject matter as the claims filed in the '470 application.
- 3. I submit this Declaration for the purpose of providing evidence that the subject matter claimed in the above-captioned application was conceived in the United States of America as of a date prior in time to May 28, 1998, and that I diligently worked toward a reduction to practice in the United States from a time prior to May 28, 1998 up until my constructive reduction to practice, the filing date of the '470 application, September 21, 1998.

- 4. I have also been informed that Aggarwal, U.S. Patent No. 6,239,867, (hereinafter, "Aggarwal"; a copy of which is attached hereto as Exhibit "A"), was cited against the claims pending in the above-captioned application.
- 5. Further, I have been informed that the effective date of Aggarwal as an alleged prior art reference is May 28, 1998.
- 6. To establish the date of conception of my invention prior to May 28, 1998, I provide evidence in the form of a copy of a letter from Lawrence J. Chapa, my patent counsel, to Terry W. Kramer, enclosing a four-page invention disclosure that I prepared, a true and correct copy of which is attached hereto as Exhibit "B" (dates have been redacted from Exhibit "B"). The invention disclosure was prepared in the United States, where my invention was also conceived, prior to May 28, 1998. The invention disclosure describes the invention of the above-noted patent application, and specifically includes a description of a computerized diamond appraisal service system and method including the use of predetermined gemstone data as an input and computing a pricing estimate for use in an evaluation report. Page 2 of the invention disclosure sets forth a sample procedure input (that includes blanks for the entry of data corresponding to cut type, weight, color, clarity, and cut proportions, including depth percentage, girdle thickness, culet, and finish) and an appraisal document (evaluation report) that includes average retail selling price data.
- 7. Subsequent to sending the invention disclosure to my patent counsel, I worked diligently toward a reduction to practice of my invention. Specifically, during the spring and summer of 1998, I worked diligently with my patent counsel to analyze patentability search results and to prepare the '470 patent application. Also, I sought and engaged a software specialist, Steve Finkelman, by April of 1998, to implement my invention, as evidenced by Exhibit "C" attached hereto, which is a true and correct copy of a listing of payments made to Steve Finkelman and an IRS Form 1099-MISC for 1999, setting

forth compensation paid to Steve Finkelman for the work he performed to implement my invention. Steve Finkelman and I worked diligently to develop a commercial software product which would enable the practice of my invention. During this same period, including the period throughout 1998, I continued to work full time in my primary profession as a retail jeweler.

- 8. As evidence of my diligence toward the filing of the '470 application, submitted herewith as Exhibit "D" are true and correct copies of a letter dated March 23, 1998, from my patent counsel to me, reporting the receipt of a patentability search regarding my invention, and facsimile cover sheets dated August 12, 1998, September 11, 1998, and September 16, 1998 from my patent counsel to me, forwarding drafts of the '470 application.
- 9. All statements made herein of my own knowledge are true and all statements made on information and belief are believed to be true; and further these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code, and such willful false statements may jeopardize the validity of the application or patent issued thereon.

0 /-04-05 Date

Peter J. Malenkoff

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VIA FACSIMILE

Mr. Terry W. Kramer Attorney at Law 2111 Jefferson Davis Highway Suite 1210 - North Arlington, Virginia 22202

Re:

Computerized Gemstone Appraisal System

Patent Search for Possible New U.S. Application

Our Ref: CS-1343

Dear Terry:

We would kindly request that you perform a patent search for a Computerized Gemstone Appraisal System. The Computerized Gemstone Appraisal System would be comprised of a special purpose computer or software running on a general purpose computer.

The system would further comprise of means for inputting gemstone characteristics such as carat size, color, clarity, type of stone and various dimensions. The computer/program would receive the inputs and determine the quality of the stone by using the computational model or by looking up the appropriate data in a table or database. The system would further include a means for outputting a report including the results of the computation or the data that was looked up, including a value or price for the gem stone being appraised.

As a dependent feature of the system, the system would include means for adjusting determining parameters used in the computational model or the table/database.

Access to the system would be through on-line resources such as the Internet via the world wide web. A form would be presented to the user with fields for receiving the various inputs. The results of the appraisal could be displayed on the same or a separate screen.

Mr. Terry W. Kramer

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Page 2

Please find enclosed a more detailed description of the Computerized Gemstone Appraisal System.

As always, the client is quite eager to receive the results of the search. So anything you could do to accelerate the work would be greatly appreciated. If you have any questions, please call. I can be reached at (312) 427-1300.

Very truly yours,

Lawrence J. Chapa

LJC:eab enclosures giagem.doc/1-2

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NATHAN MALNEKOFF AND SON JEWELERS COPYRIGHT EXCLUSIVE INFORMATION VIEWED WITH CONFIDENTIALITY AGREEMENT.

PLAN FOR DIAMOND APPRAISAL SHOPPING SERVICE

It is in the interest of the consumer to gain 1. INTRODUCTION. access to genuine gemological information about the quality of diamonds, to fully understand what they are buying and how much they are paying for diamonds. This appraisal software will meet the needs of the diamond consumer who wants to make an intelligent decision relating price to quality. The main problem is trying to decide which is the correct diamond for you to purchase. Your eye and memory absolutely cannot remember the fine differences of sparkle and brilliance when going from store to store to shop for diamonds. After shopping around, you become visually and mentally numb from all the sales talk and visual stimulation. To compare the brilliance of a diamond, you need an objective reference standard: an absolute method of comparing the sparkle and brilliance of different diamonds as you shop. This Diamond Appraisal Shopping Service was created to allow you, the consumer, to make an educated intelligent decision about the purchase of your special diamond.

The objective reference standard for diamonds in America is the Gemological Institute of America (GIA) official Gem Trade Laboratory Certificate, known as The GIA Cert. The GIA cert takes away the guesswork and allows you to fully understand the quality of the diamond you are purchasing. Without this information, you cannot make an intelligent decision. Without fully understanding how to interpret the information on the GIA Cert, you also cannot make an intelligent decision. The GIA is the oldest gemological institute of all the grading laboratories, and established the standards for diamond grading by which all diamonds are graded. The other diamond grading labs use the system created by the GIA to grade diamonds, but they issue certificates by grading the diamonds slightly differently than the GIA. How can you, the consumer, make an intelligent choice with all these variables and different

grading methods. You need our help to guide you.

We have created a master database of gemological appraisal information to allow you to make your decision a pleasant experience. All you have to do is collect the certificate information of all the diamonds you have seen at all the different I have seen consumers going to 20 or more jewelers looking at approx. 5 diamonds per jeweler (over 100 diamonds). How can you make an informed decision about 100 diamonds viewed over a period of time (usually weeks). I have seen consumers spend tens of hours agonizing over data they have collected, thinking that they are making the correct decision. Now that time will be reduced to less than an hour, with each diamond being objectively appraised for what you really need to know: What each diamond looks like compared to other diamonds, its relative brilliance compared to the standards of the ideal cut, and the average selling prices for that specific diamond. This service is available exclusively from Nathan Malnekoff and Son Jewelers with COMPUTERIZED DIAMOND APPRAISAL SHOPPING SERVICE. Now you can really make an intelligent decision.

SAMPLE PROCEDURE INPUT AND APPRAISAL DOCUMENT

C U S T T T T T Z Z P NAME ADRESS CITY STATE Z Z P TEL # FAX EMAIL EXP DATE EXP DATE	
TEL # FAX EMAIL FAD DATE	
CHARGECARD NAME CARD #EXP DATE	_
# OF DIAMONDS TO BE APPRAISEED X \$20 PER APPRAISAL. SUMMARY OF BEST DIAMOND FOR ALL ENTRIES (YES) \$35 TOTAL APPRAISAL SERVICE \$	
DIAMOND CERTIFICATE INFORMATION ENTRY: DIAMOND # (1-100) SHAPE AND CUTTING STYLE OF DIAMOND ANY SHAPE OTHER THAN ROUND NEEDS THE FOLLOWING INFORMATION: LENGTH MM WIDTH MM DEPTH MM CARAT WEIGHT CT. COLOR GRADE CLARITY GRADE	
PROPORTION INFORMATION: DEPTH % GIRDLE THICKNESS CULET FINISH: POLISHSYMMETRY	<u></u> ·
FLOURESCENCE COMMENTS	
ISSUING GEM LAB GIA EGL IGI AGS	
PRICE PER CARAT THE JEWELER IS ASKING FOR THIS DIAMOND \$	

DIAMOND APPRAISAL SHOPPING SERVICE FOR (CUSTOMER NAME)
(DIAMOND #1-100) (SHAPE OF DIAMOND) (CARAT WEIGHT) (COLOR) (CLARITY)
(SEE ATTACHED GIA CERT FOR DIAMOND INFO FOR THIS APPRAISAL)

THIS ROUND BRILLIANT CUT DIAMOND IS CUT WITHIN THE RANGE OF AN IDEAL CUT. IT WILL LOOK BIGGER THAN OTHER DIAMONDS WITH A DEEPER DEPTH %. THE TABLE % GIVES THIS DIAMOND MAXIMUM BRILLIANCE. THE GIRDLE IS EXCELLENT FOR DURABILITY AND STRENGTH TO RESIST BREAKING. NO CULET MEANS THE FACETS ON THE PAVILLION SIDE OF THE DIAMOND COMES TO A POINT AT THE BOTTOM OF THE DIAMOND. THE POLISH AND SYMMETRY COMBINATION CREATES A REFLECTIVE DIAMOND OF GOOD SHAPE. THE COLOR I WITH MEDIUM BLUE FLOURESCENCE WILL GIVE THIS DIAMOND A BLUER BODY COLOR, SLIGHTLY CLOSER TO A G COLOR IN APPEARANCE. THE CLARITY GRADE OF VS2 IS NOT VISIBLE TO THE EYE AND DOES NOT AFFECT THE BRILLIANCE OF THE DIAMOND. OVERALL, THIS IS AN EXCELLENT IDEAL CUT MAXIMUM BRILLIANCE DIAMOND.

THE AVERAGE RETAIL SELLING PRICES ARE AS FOLLOWS:

PREMIUM IMAGE RETAIL STORE \$7400 DISCOUNT RETAIL STORE \$5750 NEGOTIATED DISCOUNT PRICE \$5000

REDACTED

PAGE 3

OUTLINE OF DATABASE INFORMATION FLOW

- 1. FIRST DATABASE IS THE RAPPAPORT SPREADSHEETS FOR PRICING BASED UPON, SHAPE, EITHER ROUND OR PEAR SHAPE, WHICH WOULD LEAD TO ONE OF TWO DATABASES, THE ROUND LIST OR THE PEAR SHAPE LIST.
- 2. AFTER ENTERING THE SELECTED LIST, THEN THE CARAT WEIGHT WILL BRING YOU TO THE SUBLIST SPREADSHEET FOR CARAT WEIGHT. EXAMPLE, ROUND BRILLLIANT CUT .75CT WOULD LEAD US TO THE ROUND DIAMOND LIST AND THE .70CT .89CT SUBLIST. NOW WE ARE AT THE SUBLIST SPREADSHEET, WE LOCATE THE COLOR AND CLARITY WITHIN THE SPREADSHEET TO COME TO THE RAPPAPORT LIST PRICES. FOR RAPPAPORT LIST PRICE FOR ROUND DIAMOND, .75CT, G COLOR AND VS1 CLARITY, THE RAPP LIST PRICE IS PER CARAT.
- 3. THE DISCOUNT FOR ACTUAL JEWELER COST OF ANY DIAMOND WITHIN THE RAPPAPORT SYSTEM CHANGES FROM MONTH TO MONTH AND YEAR TO YEAR. WE HAVE TO BE ABLE TO CHANGE THE DISCOUNTS OFF THE RAPPAPORT LIST PRICES TO COME TO THE ACTUAL PRICE PER CARAT COST TO THE JEWELER. THIS DISCOUNT IS DIFFERENT FOR DIFFERENT SIZES OF DIAMONDS AND SHAPES OF DIAMONDS AT ANY GIVEN TIME. THIS DISCOUNT PERCENTAGE WILL HAVE TO BE ADJUSTABLE AND EASY TO CHANGE IN THE PROGRAMING OVER TIME AND BUILT INTO THE SYSTEM TO COME TO THE ACTUAL COST TO THE JEWELER FOR EACH DIAMOND WITHIN THE SPREADSHEET. THIS IS KNOWN AS "THE BACK OF RAPP PRICE" WHICH IS THE PERCENTAGE OFF THE LIST PRICE WITHIN THE SPREADSHEET.
- 4. THE NEXT SPREADSHEET WILL BE THE PROPORTION SPREADSHEET WHICH WILL TELL US HOW WELL THE DIAMOND IS CUT. I WILL HAVE A DESCRIPTIVE SENTENCE FOR EACH COMBINATION OF DEPTH & AND TABLE & AND GIRDLE THICKNESS FOR ALL PROPORTIONS INFORMATION, WITH THE EXAMPLE ON PAGE TWO FOR HOW THE DESCRIPTION WILL APPEAR. ONCE WE HIT THE CORRECT COMBINATION OF PROPORTION INFORMATION, THERE WILL BE A PRICE & REDUCTION OR ADDITION PLACED ONTOP OF THE PRICE ALREADY DERIVED FROM THE "BACK OF RAPP PRICE" IN PARAGRAPH #3. THE FLOURESCENCE AND COMMENTS SECTION WILL HAVE ANOTHER & REDUCTION IF THERE IS ANY FLOURESCENCE OR COMMENTS ON THE CERTIFICATE. THEN THERE WILL BE A PRICE & REDUCTION FOR CERTIFICATES OTHER THE GIA GTL CERTIFICATE. THIS WILL PRODUCE A FINAL ACTUAL COST TO THE JEWELER THAT IS THE SAME FOR MOST JEWELERS THROUGHOUT THE COUNTRY.
- 5. FOR ALL SHAPES OF DIAMONDS OTHER THAN ROUND, THE LENGTH, WIDTH, AND DEPTH IN MM WILL CREATE WHAT IS CALLED THE "LENGTH TO WIDTH RATIO." THIS RATIO SHOWS US THE BEST OPTIMUM SHAPE FOR THAT FANCY CUT DIAMOND. THIS IS INDEPENDENT OF THE DEPTH % AND TABLE %. A SENTENCE DESCRIBING THE OPTIMUM LENGTH TO WIDTH RATIO AND THE ACTUAL RATIO FOR THAT DIAMOND WILL BE ADDED TO THE APPRAISAL FOR FANCY SHAPE DIAMONDS OTHER THAN ROUNDS.

- 6. EACH DIAMOND WILL GET AN ANALYSIS OF THE PROPORTIONS AND WHAT THE PARAMETERS MEAN, WHAT THE COLOR WILL LOOK LIKE, AND IF THE CLARITY IS A PROBLEM, AND THE DIFFERENT PRICES, SIMILAR TO THE SAMPLE APPRAISAL ON PAGE 2.
- 7. THE SUMMARY OF THE BEST DIAMOND FOR ALL ENTRIES IS A SPECIAL FEATURE THAT LOOKS AT THE BEST CUT DIAMOND, THE BEST COMBINATION OF COLOR AND CLARITY FOR THE BEST CUT, AND THE BEST PRICE PER CARAT FOR THAT COMBINATION AND ALL DIAMOND ENTRIES. THIS SERVICE WILL ALLOW THE SHOPPER TO MAKE AN INTELLIGENT DECISION BASED ON COMBINING PRICE AND QUALITY. THIS WILL INVOLVE SOME COLLATING OF THE TOTAL DATA OF ALL THE SELECTED DIAMONDS.
- 8. BASED UPON THE ACTUAL COST, WHICH IS A HIDDEN PRICE WITHIN THE SOFTWARE, THE SOFTWARE WILL THEN CALCULATE THE DIFFERENT PRICES FOR EACH DIAMOND AT THREE DIFFERENT JEWELERY LOCATIONS: PREMIUM IMAGE RETAIL STORE KEYSTONE 100% MARKUP, DISCOUNT RETAIL STORE WHICH IS 55% MARKUP, AND NEGOTIATED DISCOUNT PRICE WHICH IS A 35% MARKUP OVER COST.
- 9. QUESTIONS FOR PROGRAMMER: HOW TO LIMIT THE USE OF THE PROGRAM TO HOW MANY APPRAISALS THEY ARE PAYING FOR IN ADVANCE, BUILDING A FIREWALL TO KEEP OUT BADBOYS TO SEE HOW THE PROGRAM WORKS, AND INCLUDING CHARGECARD BILLING AT THE WEBSITE.

I DO BELIEVE THE WEB SERVER COMPANY CAN HANDLE THE CHARGECARDS OR I CAN SETUP A CHARGECARD SERVICE MYSELF DIRECT BILLING TO MALNEKOFF JEWELERS.

- 10. THE TWO SPREADSHEETS TO BE USED ARE:
 - A. RAPPAPORT LIST FOR ROUNDS AND FANCIES
 - B. MALNEKOFF CUT CHARTS (VIEWED AFTER CONFIDENTIALITY (AGREEMENT IS SIGNED)
 - C. INDIVIDUAL COLOR AND CLARITY APPRAISALS THAT WILL TIE IN TO EACH COMBINATION OF COLOR AND CLARITY FROM THE RAPPAPORT LIST. THIS WILL APPEAR AS A WRITTEN APPRAISAL FOR EACH COLOR AND CLARITY COMBINATION.
 - D. INDIVIDUAL CUT APPRAISALS THAT WILL TIE IN WITH THE MALNEKOFF CUT CHARTS. THIS WILL APPEAR AS A WRITTEN APPRAISAL FOR EACH COMBINATION OF CUT INFORMATION FROM THE MALNEKOFF CUT CHARTS.
 - (THE WRITTEN APPRAISALS FOR C AND D WILL BE SUPPLIED LATER) (SEE PAGE 2 FOR WRITTEN DESCRIPTION OF APPRRAISAL)
 - E. FOR FANCY CUT DIAMONDS, THE LENGTH TO WIDTH RATIO WILL BE ANALYZED BASED ON THE FANCY CUT MALNEKOFF CUT CHARTS. THIS WILL APPEAR AS A WRITTEN APPRAISAL FOR EACH COMBINATION OF LENGTH TO WIDTH.
- 11. MONTHLY ADJUSTMENTS TO "BACK OF RAPP" PRICES % OFF THE RAPP LIST PRICES. DIFF SUBLISTS WITHIN RAPP LIST HAVE DIFFERENT % OFF THE LIST, AND THIS CHANGES MONTHLY.
 - IN ADDITION, THE RAPPAPORT PRICES WITHIN EACH SUBLIST CHANGES FROM MONTH TO MONTH. THESE MUST BE EASY TO PLUG INTO THE SOFTWARE SO THE NEW PRICES CAN BE CALCULATED CORRECTLY.



MALNEKOFF AND SONS JEWELERS LLC Vendor QuickReport All Transactions

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DEFENDANT'S DEPOSITION

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Page 1

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		2 Royatties	1999		
5 S WABASH STE 1010 CHICAGO, IL 60603-30 (312)332-7054))07	3 Other Income	Form 1099-MISC	_!	
PAYERS Federal identification number 36-4270230	RECIPIENT'S Identification number 353-46-5062	4 Federal income tax withheld	5 Fishing boat proceeds		
RECIPIENTS name, street address (include	ling spt. no.), city, state, and ZtP code	6 Medical and health care payments	7 Nonemployee compensat 25100.00	ion Internat Revenue Service If you are required to file	
STEVE FINKELMAN		8 Substitute payments in lieu of dividends or interest	9 Payer made direct sales o \$5000 or more of consum products to a buyer (recipient) for resale		
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M 01054

CONFIDENTIAL

66-5460

JOHN J. CHRYSTAL
THOMAS F. PETERSON
RICHARD J. STREIT
FREDERICK W. MEYERS
DERMOT J. HORGAN
TIMOTHY J. KEEFER
JIE SHA
LAWRENCE H. BROWN
LAWRENCE J. CHAPA
JOHN E. MCKIE*
KEITH SCHEER
(MEMBER D.C. 8AR)

224 SOUTH MICHIGAN AVENUE

CHICAGO, ILLINOIS 60604

TELEPHONE: (312) 427-1300 TELEX: 203649 CABLE: LAWLAN TELEFAX: (312) 427-6663 (312) 427-6668

52-54 HIGH HOLBORN LONDON, WC1V 6RR, ENGLAND

IAIN C. BAILLIE (MEMBER N.Y. BAR) EUROPEAN RESIDENT PARTNER ALTHEIMER ECK 2 8000 MUNICH 2. GERMANY 26 WEST 61ST STREET NEW YORK, N.Y. 10023

PAUL B. WEST
STEPHEN A. GOLDSMITH
IAN JAY KAUFMAN
FREDERICK REICHWALD
JOSEPH H. HANDELMAN
ALLAN S. PILSON
PETER D. GALLOWAY
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CLIFFORD J. MASS
JOSEPH J. VILLAPOL
(MEMBERS N.Y. BAR)

March 23, 1998

Mr. Peter J. Malnekoff Nat Malnekoff & Son Jewelers 5 South Wabash - Suite 1010 Chicago, Illinois 60603

5670 WILSHIRE BLVD.

COLIN P. ABRAHAMS
MAVIS S. GALLENSON
FRANCIE R. GOROWITZ
(MEMBERS CALIF. BAR)

RICHARD P RESG

HENRY KLEIN

LOS ANGELES, CALIF. 90036

Re:

Nat Malnekoff & Son Jewelers

Patent Search for possible New U.S. Application

Our Ref No. CS-1343

Dear Peter:

Further to our telephone discussion, wherein we discussed your ideas for a Computerized Gemstone Appraisal System, we requested a patent search be performed by our associate in Washington D.C.

We have just received the results of the search, and are in the process of reviewing the references located, . We will be back to you shortly, with the results of that review. In the interim we are forwarding to you a copy of the references. We would request that you review the references and provide us with your comments, if any.

After you have had a chance to look over the patents and we have completed our analysis, we would like to have you visit us at our offices to discuss the results of the search and how it relates to your proposed Gemstone Appraisal System. If, in the interim, you have any comments and/or questions, please do not hesitate to contact either Tim Keefer or myself.

Very truly yours,

Lawrence J. Chapa

224 SOUTH MICHIGAN AVENUE • CHICAGO, ILLINOIS 60604

Facsimile: (

(312) 427-6663

Facsimile:

(312) 427-6668

TO:

Attention: Peter J. Malnekoff Facsimile No. (312) 332-5918

FROM:

Larry Chapa

DATE:

August 12, 1998

RE:

Please find enclosed a first draft copy of an application for an automated gemstone appraisal system and method for producing an automated gemstone report we would

propose filing.

Jamy

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Thank you.

224 SOUTH MICHIGAN AVENUE • CHICAGO, ILLINOIS 60604

Facsimile:

(312) 427-6663

Facsimile:

(312) 427-6668

TO:

Attention: Peter J. Malnekoff Facsimile No. (312) 332-5918

FROM:

Larry Chapa

DATE:

September 11, 1998

RE:

Please find enclosed a second draft copy of an application for an automated gemstone evaluation system and method for producing an automated gemstone report, substantially incorporating your suggested changes, as well as other

changes.

Please review the application again, let us know if further

changes are necessary.

Janey

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Thank you.

224 SOUTH MICHIGAN AVENUE • CHICAGO, ILLINOIS 60604

Facsimile: (312) 427-6663 Facsimile: (312) 427-6668

TO: Attention: Peter J. Malnekoff

Facsimile No. (312) 332-5918

FROM: Larry Chapa

DATE: September 16, 1998

RE: further additional changes

Please find enclosed new replacement pages 10-19, incorporating the two changes we talked about and further changes to the abstract. Specifically, please note changes made on page 10, lines 24-28, and page 13, lines 18-28. The abstract is now on page 19.

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